

### **REMARKS**

Claims 1-48 remain pending in the instant application.

In the Office Action mailed July 1, 2005, Claims 1-48 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,688,833 issued to Lund et al. Claims 1-48 are rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al., by U.S. Pat. No. 6,562,880 issued to Doerge et al. and by U.S. Pat. No. 6,423,759 issued to Schilling et al, each taken individually. Claims 1-48 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al., over Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al., and over Claims 1-17 of U.S. Pat. No. 6,423,759 issued to Schilling et al, each taken individually. Claims 1-48 are provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1, 2, 5, 8 and 11-13 of copending application Serial No. 10/894,692, over Claims 1-9 of copending application Serial No. 10/965,349, over Claims 1-24 of copending application Serial No. 10/281,733 and over Claims 1-8 of copending application Serial No. 10/295,315, each taken individually

### **Rejections under 35 U.S.C. §102(b)**

Claims 1-48 stand rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,688,833 issued to Lund et al. Applicants respectfully disagree with the Examiner's contention regarding Lund et al. The Examiner states at page 2 of the instant Office Action that

Lund et al. disclose preparations of polyurethane foams having lowered K-factors, superior performance and dimensional stability which are prepared from polyisocyanates, polyol mixtures of the specificity claimed by applicants, 1,1,1,3,3-pentafluoropropane (HFC-245fa), and water....

Applicants respectfully contend that the above-reproduced statement mischaracterizes the teaching of Lund et al. In actuality, at col. 1, line 54-57, Lund et al. teach that azeotropic blowing agents confer a number of advantages upon the

foams blown with them including lower K-factors. Further, as described at col. 1, lines 7-9, the invention of Lund et al. is an azeotropic-like mixture of blowing agents containing 1,1,1,3,3-pentafluoropropane (HFC-245fa) and 1,1-dichloro-1-fluoroethane. This azeotropic-like mixture was made presumably to confer similar properties on the foams blown therewith as found with azeotropic blowing agents. In contradistinction, applicants teach (at page 8, lines 9-12 of the instant specification) and claim foams blown with 1,1,1,3,3-pentafluoropropane (HFC-245fa) alone; not in an azeotropic mixture or in an azeotropic-like mixture as in Lund et al.

At pages 2-3, the Examiner states,

The specific K-values of applicants' claims, though not particularly specified, are held to be inherent to the teachings of Lund et al. owing to the similarities in the materials employed.

The only "teaching" contained in Lund et al. regarding K-factors is given at col. 1, line 54-57, wherein they state that azeotropic blowing agents confer advantages upon the foams blown with them including lower K-factors. As the Examiner is well aware, "inherent to the teachings of ... owing to the similarities in the materials employed." is not the proper standard for a rejection under 35 U.S.C. §102(b). Further, the foam made in example 2 of Lund et al. is made with a B-side containing 70 parts by weight of a sucrose-based polyol, whereas the instant claims recite no more than about 20 % of the polyol blend being sucrose-based, thus the materials are in fact not similar. According to MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. Applicants respectfully contend that the Examiner's extrapolation of the only statement of Lund regarding azeotropic blowing agents contained in a disclosure teaching azeotropic-like blowing agents with a sucrose-based polyol in much higher amounts than instantly claimed to assert that it somehow inherently teaches the applicants' claimed 1,1,1,3,3-pentafluoropropane (HFC-245fa) blowing agent in a polyol blend with a much lower amount of sucrose-based polyol falls far short of satisfying this standard.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 9-24 and 33-48 under 35 U.S.C. §102(b), as being anticipated by U.S. Pat. No. 5,688,833 issued to Lund et al.

**Rejections under 35 U.S.C. §102(e) over Schilling et al.**

Claims 1-48 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al. Although applicants respectfully disagree with the Examiner's contention regarding Schilling et al., in the interests of expediting prosecution of the instant application and in keeping with the spirit of the PTO's Patent Business Goals (PBG) 65 Fed. Reg. 54603 (September 8, 2000), applicants herewith file a declaration under 37 CFR 1.132 stating that any invention disclosed but not claimed in U.S. Pat. No. 6,846,850 was derived from an inventor of the instant application and thus can not be considered the invention by "another" within the meaning of 35 U.S.C. §102.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,846,850 issued to Schilling et al.

**Rejections under 35 U.S.C. §102(e) over Doerge et al.**

Claims 1-48 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,562,880 issued to Doerge et al. Although applicants respectfully disagree with the Examiner's contention regarding Doerge et al., in the interests of expediting prosecution of the instant application, applicants herewith file a declaration under 37 CFR 1.132 stating that any invention disclosed but not claimed in U.S. Pat. No. 6,562,880 was derived from an inventor of the instant application and thus can not be considered the invention by "another" within the meaning of 35 U.S.C. §102.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,562,880 issued to Doerge et al.

**Rejections under 35 U.S.C. §102(e) over Schilling et al.**

Claims 1-48 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,423,759 issued to Schilling et al. Applicants respectfully disagree with the Examiner's contention regarding Schilling et al.

Applicants respectfully remind the Examiner that as stated in MPEP §2131, to anticipate a claim, a reference must teach every element of that claim. "The identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully contend that the Examiner has failed to point to where Schilling et al. do so. Specifically, the foams made in the comparative examples given in Tables 3 and 4 of Schilling et al. disclose a B-side having a sucrose-based polyol in amounts greater than that recited in the instant claims and an aromatic amine initiated polyol in lesser amounts than that recited in the instant claims.

Therefore, applicants respectfully request the Examiner reconsider and reverse his rejection of Claims 1-48 under 35 U.S.C. §102(e), as being anticipated by U.S. Pat. No. 6,423,759 issued to Schilling et al.

**Rejections under judicially created doctrine of obviousness-type double patenting over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al.**

Claims 1-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-2 of U.S. Pat. No. 6,846,850 issued to Schilling et al. Although applicants respectfully disagree with the Examiner's contention regarding Schilling et al., in the interests of expediting prosecution of the instant application and in keeping with the spirit of the PTO's Patent Business Goals (PBG) 65 Fed. Reg. 54603 (September 8, 2000), applicants herewith file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which exceeds that of U.S. Pat. No. 6,846,850 issued to Schilling et al.

**Rejections under judicially created doctrine of obviousness-type double patenting over Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al.**

Claims 1-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-14 of U.S. Pat. No. 6,562,880 issued to Doerge et al. Although applicants respectfully disagree with the Examiner's contention regarding Doerge et al., in the interests of expediting prosecution of the instant application, applicants herewith file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which exceeds that of U.S. Pat. No. 6,562,880.

**Rejections under judicially created doctrine of obviousness-type double patenting over Claims 1-17 of U.S. Pat. No. 6,423,759 issued to Schilling et al.**

Claims 1-48 stand rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-17 of U.S. Pat. No. 6,423,759 issued to Schilling et al. Although applicants respectfully disagree with the Examiner's contention regarding Schilling et al., in the interests of expediting prosecution of the instant application, applicants herewith file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of U.S. Pat. No. 6,423,759.

**Provisional rejections under judicially created doctrine of obviousness-type double patenting over copending application Serial No. 10/894,692**

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1, 2, 5, 8 and 11-13 of copending application Serial No. 10/894,692. Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/894,692 and note that the claims of that application have not yet been patented. However, in the interests of expediting prosecution of the instant application, applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/894,692.

**Provisional rejections under judicially created doctrine of obviousness-type double patenting over copending application Serial No. 10/965,349**

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-9 of copending application Serial No. 10/965,349. Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/965,349 and note that the claims of that application have yet to be patented. However, in the interests of expediting prosecution of the instant application, applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/965,349.

**Provisional rejections under judicially created doctrine of obviousness-type double patenting over copending application Serial No. 10/281,733**

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-24 of copending application Serial No. 10/281,733. Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/281,733 and note that the claims of that application have not yet been patented. However, in the interests of expediting prosecution of the instant application, applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/281,733.

**Provisional rejections under judicially created doctrine of obviousness-type double patenting over copending application Serial No. 10/295,315**

Claims 1-48 stand provisionally rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-8 of copending application Serial No. 10/295,315. Applicants respectfully disagree with the Examiner's contention regarding copending application Serial No. 10/295,315 and note that the claims of that application have yet to be patented. However, in the

interests of expediting prosecution of the instant application, applicants herewith offer to file a terminal disclaimer disclaiming that portion of the term of any patent granted in the instant application which would exceed that of copending application Serial No. 10/295,315.

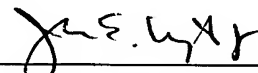
### **Conclusion**

Applicants have corrected a typographical error in the Specification and have amended Claims 9 and 33 to correct an antecedent basis error. Such amendments are to be construed as "truly cosmetic" and are not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicants also contend that such claim amendments add no new matter and find support in the specification.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-48. If the Examiner is of the opinion that the instant application is in condition for other than allowance, he is invited to contact the applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By



John E. Mrozinski, Jr.  
Attorney for Applicants  
Reg. No. 46,179

Bayer MaterialScience LLC  
100 Bayer Road  
Pittsburgh, Pennsylvania 15205-9741  
(412) 777-3024  
FACSIMILE PHONE NUMBER:  
(412) 777-3902  
s:\shared\jmf\JEM8044.ame